



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/526,692	08/04/2005	David Norman Leach	DAV1124.001APC	5279

20995 7590 11/26/2010  
KNOBBE MARTENS OLSON & BEAR LLP  
2040 MAIN STREET  
FOURTEENTH FLOOR  
IRVINE, CA 92614

EXAMINER
----------

KASSA, TIGABU

ART UNIT	PAPER NUMBER
----------	--------------

1619

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

11/26/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com  
efiling@kmob.com  
eOAPilot@kmob.com

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/526,692	LEACH ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	TIGABU KASSA	1619	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period **will** apply and **will** expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply **will**, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 26,27,29,31,36,38,40,41,44-46,52-57,79 and 83 is/are pending in the application.
- 4a) Of the above claim(s) 33,36,38,40 and 83 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 26-27, 29, 31, 41, 44-46, 52-57, and 79 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                      |                                                                   |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                          | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Request for Continued Examination***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09/20/2010 has been entered.

### ***Formal Matters***

Applicant's amendments filed on 09/20/2010 are acknowledged and entered due to request for continued examination. **Claims 26-27, 29, 31, 36, 38, 40-41, 44-46, 52-57, 79, and 83 are pending. Claims 26-27, 29, 31, 41, 44-46, 52-57, and 79 are under consideration in the instant office action.** Claims 33, 36, 38, 40, and 83 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claims. Claims 1-25, 28, 30, 32, 34-35, 37, 39, 42-43, 47-51, 58-78, and 80-82 are cancelled. Claim 83 is newly added. Applicant's claim amendments did not overcome the rejections because the instantly recited genus structure is clearly taught by Maupin et al.

### ***Rejections Maintained***

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 1619

(a) A patent may not be obtained though the invention is not identically taught or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(c), (f) or (g) prior art under 35 U.S.C. 103(a).

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness

**Claims 26-27, 29, 31, 41, 44-46, 52-57, and 79 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Maupin et al., (WO 02/50053, IDS reference) in view of Chetty et al., (Tetrahedron Letters 1969, 5, 307-309, IDS reference) and as evidenced by Gonzalez-Coloma et al., (Journal of Chemical Ecology 1995, 21 1255-1270), for the reasons of record and the reasons set forth herein.**

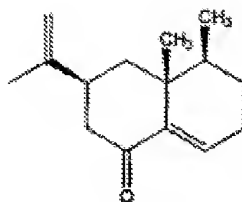
*Response to arguments*

Applicant's arguments filed on 09/20/10 have been fully considered but they are not persuasive.

*Applicant argues that the formula (I) as defined in the amended Claim 26 specifically recites eremophilone, 8-hydroxy- 1(10)dihydroeremophilone, 9-hydroxy-7(11),9-eremophiladien-8-one, and 8-hydroxyeremophila -1,11-dienone and their derivatives, but excludes eremophilene. Eremophilene shares some structural features with the cited eremophilone compounds; however, it has no activity in controlling termites. This was established in Table 1 of the declaration submitted on October 22, 2009.*

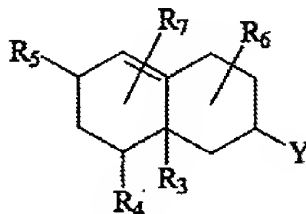
This is not found persuasive because even though the structure shown in claim 26 is eremophilone the claim language uses the transitional phrase "comprising". Therefore, the inclusion of other compounds such as eremophilene and other steps are not excluded from the method recitation. The transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. See, e.g., *Mars Inc. v. H.J. Heinz Co.*, 377 F.3d 1369, 1376, 71 USPQ2d 1837, 1843 (Fed. Cir. 2004) ("like the term comprising,' the terms containing' and mixture' are open-ended."); and *Invitrogen Corp. v. Biocrest Mfg., L.P.*, 327 F.3d 1364, 1368, 66 USPQ2d 1631, 1634 (Fed. Cir. 2003). More importantly the examiner brings to applicant's attention that Maupin et al., indeed teach the instantly recited structure as the examiner explained in the previous office action. The examiner reminds applicant that based on the restriction requirement mailed on 11/26/08 applicant has elected as single species the following compound:

Art Unit: 1619



Previous rejections also cover applicant's elected species. Maupin et al., teach the genus of structures of the compounds of the instant application. Maupin et al., also teaches structures that encompass the instantly claimed compounds as follows

Certain other exemplary pesticidal eremophilane sesquiterpenes are represented by Formula III:



Formula III

where Y is

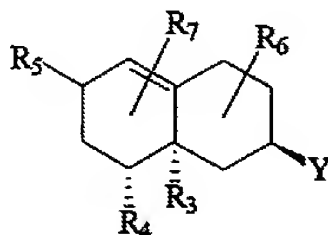


and, similar to the R-groups of Formula I,  $R_1$ ,  $R_2$ ,  $R_3$ ,  $R_4$ ,  $R_5$ ,  $R_6$ ,  $R_7$ , and  $R_8$  are each independently H, =O, -OH, lower aliphatic, lower aliphatic alcohol, lower aliphatic thiol, carbonyl containing lower aliphatic, thiocarbonyl containing lower aliphatic, lower aliphatic ether, or lower aliphatic epoxide. Additionally, the eremophilane ring structures of compounds described by Formula III may contain double-bonds as described with respect to Formulas I and II.

The compounds of Formula III form a subset of the compounds described by Formulas I and II, and all chemical substitutions and modifications discussed in relation to Formulas I and II are possible at the corresponding structure positions on Formula III.

Please see the whole page 20

In some embodiments, a compound according to Formula III is a specific stereoisomer, such as:



In some embodiments, lower aliphatic is a lower alkyl; lower aliphatic alcohol is a lower alkyl alcohol; lower aliphatic thiol is a lower alkyl thiol; lower aliphatic carboxylic acid is a lower alkyl carboxylic acid; carbonyl containing lower aliphatic is a lower carbonyl containing alkane; thiocarbonyl containing lower aliphatic is a lower thiocarbonyl containing alkane; lower aliphatic ether is a lower alkane ether; and lower aliphatic epoxide is a lower alkane epoxide.

In some embodiments, R<sub>3</sub>, R<sub>4</sub>, R<sub>5</sub>, R<sub>6</sub>, R<sub>7</sub>, and R<sub>8</sub>, are independently =O, –OH, lower aliphatic alcohol, carbonyl containing lower aliphatic, lower aliphatic ether, or lower aliphatic epoxide. In alternative embodiments, several of R<sub>3</sub>, R<sub>4</sub>, R<sub>5</sub>, R<sub>6</sub>, R<sub>7</sub>, and R<sub>8</sub>, are substituents and the others are H. For example, R<sub>3</sub>, R<sub>4</sub>, and R<sub>5</sub> can be substituents and the others H. In particular embodiments, R<sub>5</sub> is =O, –OH, lower aliphatic, lower aliphatic alcohol, carbonyl-containing lower aliphatic, lower aliphatic ether, or lower aliphatic epoxide. In more particular embodiments, R<sub>5</sub> is =O, or –OH and R<sub>3</sub>, and R<sub>4</sub> are lower aliphatic, such as lower alkyl (e.g., methyl or ethyl).

Please see the whole page 21

It is not clear to the examiner why applicant choose to point out the differences between eremophilene and eremophilone at this point since Maupin et al., clearly teach structures that resemble and encompass the instantly claimed compounds as clearly showed above. However, Maupin et al., teach other compounds instead of or in addition to the instantly elected species that may also be used in pest control. It is for this reason that the examiner brought into the rejections Chetty et al. The examiner notes that the instantly selected species was taught by Chetty et al., in “7a(H)-Eremophila-1,11-dien-9-one. A New sesquiterpene for the Eremophilane Type.” (Tetrahedron Letters 1969, 5, 307-309). Obviousness can be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so *In re Kahn*, 441 F.3d 977, 986, 78 USPQ2d 1329, 1335 (Fed. Cir. 2006). The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art, and all teachings in the prior art must be considered to the extent that they are in analogous arts. In the instant case, Chetty et al., clearly provides clarification of the elected species in single embodiment rather in genus disclosure with various substituent R-groups that encompass the elected species as set forth above.

*Applicant further argues that as seen from the results that applicant submitted with the declaration filed on 10/22/09 which is reproduced in the instant remarks as well, eremophilene, a compound with no 9-oxo group and no oxygenation in the 9-position has no bioactivity. In contrast, EM-1 to EM-3 and EM-5 (i.e. eremophilone, 8-hydroxy-1(10)dihydroeremophilone, 9-hydroxy-7(11),9-eremophiladien-8-one, and 8-hydroxyeremophila-1,11-dienone, respectively) of the claimed inventions having a 9-oxo group or oxygenation at the 9-position derived from a 9-oxo group (a tautomer), have good bioactivities in killing termites.*

Applicant's data is not persuasive because **applicant is relying upon a non-analogous comparative showing to rebut a prima facie case. In making a comparative showing, Applicant is required compare his claimed invention with closest prior art** *In re Holladay*, 584 F.2d384, 199 USPQ 516 (CCPA 1978); *Ex parte Humber*, 217 USPQ 265 (Bd. App. 1961). Applicants did not compare their data with Maupin et al. Applicant, who has neither established nor asserted that teachings of two closest prior art references are so parallel to one another that testing against one would show relative effectiveness of claimed invention over other.

Accordingly, Applicant did not provide adequate basis to rebut conclusion of obviousness. Showing unexpected results over prior art references will not rebut *prima facie* obviousness unless the teachings of the prior art references are sufficiently similar to each other that the testing of one showing unexpected results would provide the same information as to the other. *In re Johnson*, 747 F.2d 1456, 1461, 223 USPQ 1260, 1264 (Fed. Cir. 1984). Furthermore, from an experimental data perspective, Applicant's results are not commensurate in scope with the claims. Applicant is claiming all compounds with the recited genus structure wherein bioactivity is shown only for four. Objective evidence of nonobviousness must be commensurate in scope with the claims. The showing of unexpected results must be reviewed to see if the results occur over the entire claimed range. *In re Clemens*, 622 F.2d 1029, 1036, 206 USPQ 289, 296 (CCPA 1980). Likewise, mere conclusory statements in specification and affidavits are entitled to little weight when Patent Office questions efficacy of statements. *In re Lindner*, 457 F.2d 506, 509, 173 USPQ 356, 359 (CCPA 1972). The examiner is aware of the fact that the nonobviousness of a broader claimed genus can be supported by evidence based on unexpected results from testing a narrower range if one of ordinary skill in the art would be able to determine a trend in the

exemplified data which would allow the artisan to reasonably extend the probative value thereof. *In re Kollman*, 595 F.2d 48, 201 USPQ 193 (CCPA 1979). However, in the instant case, one of ordinary skill in the art cannot extrapolate a trend from the single data point Applicant uses for the eremophilene compound in addition to not doing the comparison with the structures taught by Maupin et al.,.

*Applicant also argues that Maupin teaches a variety of compounds as pest-controlling agents. The broad disclosure of Maupin including that is disclosed in page 20 and 21 may encompass eremophilene and some eremophilone compounds. However, there is no disclosure in Maupin that eremophilene and eremophilone compounds would have drastically different activities in pest control. More particularly, there is no disclosure and suggestion in Maupin that the eremophilone compounds, but not eremophilene, have significant bioactivities, especially in controlling termites. Rather, in view of Maupin, it appears that eremophilene and eremophilone compounds would have similar activities in controlling pests. Accordingly, the uniquely high bioactivities of the eremophilone compounds and a method of controlling termites using the eremophilone compounds cannot be anticipated or obvious in light of Maupin.*

The examiner notices that Applicant clearly admitted on the record that Maupin et al., teach eremophilone compounds. Applicant's arguments are not found persuasive because applicant's claimed compounds are clearly taught by the genus structures of Maupin et al., the motivation or the suggestions of the prior art does not necessarily have to match with what applicant assert as surprising finding. The reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same

advantage or result discovered by applicant. See, e.g., *In re Kahn*, 441 F.3d 977, 987, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) (motivation question arises in the context of the general problem confronting the inventor rather than the specific problem solved by the invention); *Cross Med. Prods., Inc. v. Medtronic Sofamor Danek, Inc.*, 424 F.3d 1293, 1323, 76 USPQ2d 1662, 1685 (Fed. Cir. 2005) (“One of ordinary skill in the art need not see the identical problem addressed in a prior art reference to be motivated to apply its teachings.”); *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972); *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990), *cert. denied*, 500 U.S. 904 (1991). The recognition by Maupin et al., for both eremophilene and ermophilone compounds being useful for controlling pests is a strong indication that they are capable of being used for controlling pests. The burden is on applicant to show that either Maupin et al., do not teach the instantly recited genus structure or compare the results with the closest structures with the instantly claimed compounds. Because Maupin et al., clearly teach the eremophilone compounds that applicant recited therefore any comparison experiment is expected to result in similar effect. Maupin et al., teach pesticidal sesquiterpenes which include eremophilone (formula III, page 20, lines 2-5). Pesticidal compositions teach include one or more of the teach eremophilane sesquiterpenes (page 33, lines 11-13). The compounds have deterrent, repellent and/or toxic effects on certain pest targets and may function as pest repellents or pest control agents, as well as pesticides (page 36, lines 29-31). The efficacy and quantity of a pesticidally effective amount for a given compounds maybe determined by routine screening procedures (page 37, lines 12-15). Additionally, the appropriateness of a compound of composition may be assessed by observing any adverse effects to the person applying the composition to an infested plant, animal, or environmental locus (page 37, lines 26-

29). Maupin et al. also teach methods of using the eremophilane sesquiterpenes as pesticides (page 39, line 7). The compound or composition is administered in a pesticidally effective amount (page 39, lines 27-28). The amount, frequency and number of applications may depend on a variety of factors including, among other things the feeding habits of the pest (page 40, lines 11-16). Methods of application include spraying, atomizing, dusting, immersing, coating, dressing, scattering, and pouring (page 41, lines 8-9). The formulations may be used to kill or repel pests (page 42, line 1). The examiner notes that effective antifeedant amounts of the compound would result in either starving the pest (i.e. killing) or repelling the pest as it is forced to find food elsewhere. The formulation may kill or repel a pest by directly contacting the pest, may be induced into the atmosphere of the locus, or may be applied to a plant or inanimate object (page 42, lines 9-12). **Certain embodiments encompass protection of homes, buildings or other structures from nuisance insects, such as termites** (page 42, lines 13-14). The compound or composition may be applied to a locus within or outside including spraying onto floors or cupboards or soaking the ground outside the structure (page 42, lines 19-22). Additionally, the compound or composition may be embedded within materials used to construct the structure, such as siding, wall studs, or beams (page 42, lines 22-24). Compounds or compositions taught may also be applied to the soil (page 43, line 25). These application methods would include applying the composition around the site or mixing with a layer of soil at the site. They would also include application to sites prior to and after infestation.

*Applicant also argues by stating that applicants noted that Examiner's comment that plants are commonly known to produce compounds which are effective against infestations, diseases, and other threats that plant faces, and accordingly it is not surprising that*

*eremophilone would be effective at controlling pests such as termites. Both of eremophilene and eremophilone compounds are known to be present in plants; however, as shown in the above Table 1, only the eremophilone compounds have significant bioactivities against termites and eremophilene has almost no activity. Therefore, these unique activities of the eremophilone compounds and use thereof in controlling termites should be indeed surprising and unexpected according to the foregoing Examiner's view. Thus, Chetty adds nothing to lead a person with ordinary skill in the art to expect or anticipate the subject matter of the pending claims.*

This is not found persuasive because Maupin et al., teach other compounds instead of or in addition to the instantly selected species may also be used in pest control. It is for this reason that the examiner brought into the rejections Chetty et al., The examiner notes that the elected species was taught by Chetty et al., in “7a(H)-Eremophila-1,11-dien-9-one. A New sesquiterpene for the Eremophilane Type.” (Tetrahedron Letters 1969, 5, 307-309). Applicant's arguments in this section are also rebutted for the same reasons set forth above.

*Applicant also argues that as noted, nothing in the prior art would lead one having ordinary skill in the art to predict the Applicants' demonstration of the bioactivity of eremophilone compounds against termites and the claimed methods using the same to control termites. The claims have been narrowed to cover a class of compounds commensurate in scope with the data provided in the Declaration for which unexpected results were shown. Accordingly, the presently pending claims are nonobvious over the cited prior art in light of the significant unexpected results demonstrated for the claimed invention.*

This is not found persuasive because partly based on the reasons set forth above and also given the fact that one of ordinary skill in the art would have reasonably known that the

compounds of Maupin et al., which are also clearly suggested to be effective on termites by stating that **certain embodiments encompass protection of homes, buildings or other structures from nuisance insects, such as termites** (page 42, lines 13-14), would be capable of killing termites since Maupin et al., clearly teach applicant's claimed genus structure and also the elected species in a genus structure. Therefore, it is not surprising that eremophilone would be effective at controlling pests, particularly pests known to infest wood, e.g. termites.

### **Double Patenting**

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 26-27, 29, and 31 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 13-16, 19-20, 32-33, and 37-38 of U.S. Patent No. 7,129,271 in view of Chetty et al. (Tetrahedron Letters 1969, 5, 307-309, IDS reference), for the reasons of record and the reasons set forth herein.

***Response to arguments***

Applicant argues that because of the above arguments set forth to overcome the rejection under 35 U.S.C. § 103(a) the double patenting rejection should be withdrawn.

The examiner incorporates the above rebuttal arguments by reference since they clearly apply in this section too since applicant argue the same thing as above. The rejection is maintained.

***Request for Rejoinder***

*Upon allowance of Claim 26, Applicant respectfully request that Claims 33, 36, 38, 40 and 83 be rejoined and allowed as being dependent on and requiring all the limitations of an allowable claim. See M.P.E.P. § 821.04.*

Since claim 26 is not found to be allowable claims 33, 36, 38, 40 and 83 will not be rejoined and remain withdrawn from further considerations.

**Conclusion**

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TIGABU KASSA whose telephone number is (571)270-5867. The examiner can normally be reached on 9 am-5 pm Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne P. Eyler can be reached on 571-272-0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Tigabu Kassa

11/20/10

/Cherie M. Woodward/  
Primary Examiner, Art Unit 1647